

Applicants: Hermona Soreq et al.
Serial No.: 09/998,042
Filed: November 30, 2001
Page 16

REMARKS

Claims 1-17 are pending in the subject application. Applicants note that the Examiner has withdrawn claims 11-17 from further consideration. Applicants have hereinabove amended claims 1-3 and 5-10. Support for the phrase "corresponds to" in claim 1 may be found inter alia in the specification on page 25. In addition, support for the term "isolated" in claims 1, 3 and 5-10 may be found inter alia in the specification on page 25. The remaining amendments to the claims are for clarification only and do not present any issue of new matter. Therefore, entry of this Amendment is respectfully requested such that claims 1-3 and 5-10 will be pending and under examination.

In addition, the specification was also hereinabove amended. Applicants note that this amendment was made to add information regarding federal funding of the subject application and does not present any issue of new matter.

In view of the arguments and amendments set forth below, applicants maintain that the Examiner's objections and rejections have been overcome and respectfully request that the Examiner reconsider and withdraw same.

Election/Restriction

The Examiner stated that claims 11-17 are withdrawn from consideration as being drawn to non-elected subject matter. The Examiner stated that the products and methods of making and using those products were restricted in the paper filed July 25, 2003. The Examiner stated that applicants elected Group I, claims 1-17, drawn to a regulatory peptide. The Examiner stated

Applicants: Hermona Soreq et al.
Serial No.: 09/998,042
Filed: November 30, 2001
Page 17

that applicants have amended previously elected products claims 11-17 to now be drawn to methods of using the previously elected product of the inventive Group I. The Examiner stated that, therefore, as claims 11-17 are now drawn to non-elected subject matter, claims 11-17 are withdrawn from consideration.

In response, applicants respectfully traverse. Applicants note that claim 1 is directed to a single species, i.e. a regulatory peptide comprising SEQ ID NO:1. Withdrawn claims 11-17 are directed to methods of using the regulatory peptide of claim 1. Applicants maintain that claims 1-3 and 5-17 are related and therefore not "independent". Therefore, it would not be a burden on the Examiner to examine claims 1-3 and 5-10 with claims 11-17 in the subject application. Accordingly, applicants respectfully request that the Examiner reconsider and rejoin claims 11-17 such that claims 1-3 and 5-17 will be under examination.

Claim Rejections Under 35 U.S.C. §112, First Paragraph

The Examiner rejected claims 2-3 and 5-10 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner stated that the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The Examiner stated that this is a "written description" rejection, rather than an enablement rejection under 35 U.S.C. §112, first paragraph. The Examiner directed applicants to the Guidelines for the Examination of Patent Applications Under the 35 U.S.C. §112, "Written Description" Requirement (Federal

Applicants: Hermona Soreq et al.
Serial No.: 09/998,042
Filed: November 30, 2001
Page 18

Register, Vol. 66, No. 4, pages 1099-1 111, Friday January 5, 2001).

The Examiner stated that a review of the language of the claims indicates that these claims are drawn to a genus, i.e., synthetic peptides comprising SEQ ID NO: 1 and deletions, additions and substitutions thereof. The Examiner stated that a description of a genus may be achieved by means of a recitation of a representative number of species falling within the scope of the genus or of a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus (*Regents of the University of California v. Eli Lilly Co.*, 119 F3d 1559, 1569, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997)). The Examiner stated that in *Regents of the University of California v. Eli Lilly* (43 USPQ2d 1398-1412), the court held that a generic statement which defines a genus of nucleic acids by only their functional activity does not provide an adequate written description of the genus. The Examiner stated that the court indicated that, while applicants are not required to disclose every species encompassed by a genus, the description of the genus is achieved by the recitation of a representative number of species falling within the scope of the claimed genus. The Examiner stated that at section B(1), the court states "An adequate written description of a DNA requires a precise definition, such as by structure, formula, chemical name, or physical properties, not a mere wish or plan for obtaining the claimed chemical invention".

The Examiner stated that there are no specifically indicated species of the claimed genus disclosed that are within the scope of the claimed genus, i.e. peptides that are variants of SEQ ID NO: 1 as defined by disclosed specific deletions, substitutions

Applicants: Hermona Soreq et al.
Serial No.: 09/998,042
Filed: November 30, 2001
Page 19

and additions. The Examiner stated that the disclosure of one or two species may provide an adequate written description of a genus when the species disclosed are representative of the genus. The Examiner stated that, however, the present claims encompasses numerous species that are not further described. The Examiner stated that there is substantial variability among the numerously possible species. The Examiner stated that one of skill in the art would not recognize from the disclosure that the applicant was in possession of the genus comprising synthetic peptides comprising variants of SEQ ID NO: 1 by deletions, additions and substitutions thereof. The Examiner stated that the specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed" (citing *Vas-Cath* at page 1116). The Examiner stated that applicant is reminded that *Vas-Cath* makes clear that the written description provision of 35 U.S.C. §112 is severable from its enablement provision (citing page 1115).

In response, applicants respectfully traverse the Examiner's above rejection. Nevertheless, without conceding the correctness of the Examiner's position but to expedite prosecution of the subject application, applicants have hereinabove amended claim 2 to address the claim language objected to by the Examiner.

In view of the above remarks, applicants contend that claim 2, and claims 3 and 5-10 which depend therefrom, satisfy the written description requirement of 35 U.S.C. §112, first paragraph. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Applicants: Hermona Soreq et al.
Serial No.: 09/998,042
Filed: November 30, 2001
Page 20

Claim Rejections Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claims 1-3 and 5-10 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The Examiner stated that claim 1 is vague and indefinite in that the metes and bounds of the terms "derived from" are unclear. The Examiner stated that it is unclear the nature and number of steps required to obtain a regulatory peptide "derivative" from the C-terminal region of the read through variant of acetylcholinesterase. The Examiner stated that the term implies a number of different steps that may or may not result in a change in the functional characteristics of the regulatory peptide as claimed from the source that it is "derived from". The Examiner stated that claims 2-3 and 5-10 are rejected for depending from rejected claims.

In response, applicants respectfully traverse the Examiner's above rejection. Nevertheless, applicants without conceding the correctness of the Examiner's position but to expedite prosecution of the subject application have hereinabove amended claim 1 to address the claim language objected to by the Examiner.

In view of the above remarks, applicants contend that claim 1, and claims 2-3 and 5-10 which depend therefrom, satisfy the requirements of 35 U.S.C. §112, second paragraph. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Applicants: Hermona Soreq et al.
Serial No.: 09/998,042
Filed: November 30, 2001
Page 21

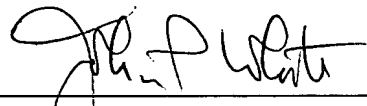
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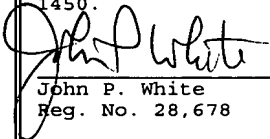
For the reasons set forth hereinabove, applicants respectfully request that the Examiner reconsider and withdraw the various grounds of rejection and earnestly solicit allowance of the now pending claims, i.e. claims 1-3 and 5-10, and rejoinder of claims 11-17.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the \$55.00 fee for a one-month extension of time, is deemed necessary in connection with the filing of this Amendment. If any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
	10/25/04
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